



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,432	03/26/2004	Nobukata Okano	SON-2981	8124
23353 7590 07/31/2007 RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			EXAMINER KIM, DAVID S	
			ART UNIT 2613	PAPER NUMBER
			MAIL DATE 07/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/809,432

Applicant(s)

OKANO ET AL.

Examiner

David S. Kim

Art Unit

2613

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 16 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: none.
Claim(s) rejected: 3,4 and 21-39.
Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☒ Other: See Continuation Sheet.


**KENNETH VANDERPUYE
SUPERVISORY PATENT EXAMINER**

Continuation of 3. NOTE:

AMENDMENTS

Applicant's proposed amendment introduces limitations absent from the previous version of the claims. In doing so, the proposed amendment raises new issues related to a change in the scope of the claims. A proper and sufficient response to these new issues would require further consideration and/or search.

In particular, notice the introduction of new claims 40-59. Claim 24 is the parent independent claim for claims 40-59. Previous versions of the claims did not include any embodiment of Applicant's invention(s) that includes the limitations of claim 24 *and* the limitations introduced by claims 40-59. Accordingly, Applicant's amendment introduces embodiment(s) of Applicant's invention(s) that were absent from the previous version of the claims. In doing so, the proposed amendment raises new issues related to a change in the scope of the claims. A proper and sufficient response to these new issues would require further consideration and/or search.

Continuation of 11. does NOT place the application in condition for allowance because:

ARGUMENTS

Applicant's arguments (filed on 16 July 2007) have been fully considered but are not persuasive. Applicant presents two salient points.

Regarding the first point, Applicant contests the obviousness argument for claim 24 presented in the Final Rejection (mailed on 01 June 2007):

"Applicant hereby requests a reference or an Examiner's affidavit to support this officially noticed position of obviousness or what is well known that one of ordinary skill in the art would have been motivated to do this for a compact device" (REMARKS, p. 13, 2nd paragraph).

Examiner respectfully points to the teachings of Dowling et al. (WO 02/25842 A2, hereinafter "Dowling") to reply to Applicant's request. Notice the mounting of module 716 onto base 702 in Fig. 7. Module 716 is an output device that may emit an optical signal (p. 45, l. 17-19). Base 702 may be an illumination light source (p. 44, l. 17-21). Consider the alternate configuration of mounting module 716 separately from illumination light source 702. Clearly, the configuration shown in Fig. 7 would provide a more compact device. Accordingly, Applicant's first point is not persuasive.

Regarding the second point, Applicant contests the obviousness argument for claim 29 presented in the Final Rejection (mailed on 01 June 2007):

"Applicant hereby requests a reference or an Examiner's affidavit to support this officially noticed position of obviousness or what is well known that one of ordinary skill in the art would have been motivated to do this since removable memory is easy to replace, reprogram, and transport" (REMARKS, p. 16, 4th paragraph).

Examiner respectfully points to the teachings of Newton (Newton's Telecom Dictionary, 8th ed.) to reply to Applicant's request. Notice the terms "removable media" (p. 868), "removable cartridge system" (p. 868), "floppy disk" (p. 452), and "floppy mini" (p. 453). These are all well known examples of removable memory. The example of the "floppy disk" is easy to replace, reprogram, and transport. Accordingly, Applicant's second point is not persuasive.

Summarily, Applicant's arguments are not persuasive. Accordingly, Examiner respectfully maintains the standing rejections.

Continuation of 13. Other:

FINALITY OF THE MOST RECENT OFFICE ACTION (mailed on 01 June 2007)

Applicant contests the finality of the most recent office action by stating:

"Paragraph 13 of the Final Office Action admits that the rejections of claims 3 and 4 found within paragraphs 3 and 4 of the Final Office Action are new grounds of rejection.

Thus, the new rejection of claims 3 and 4 made within the Final Office Action are new grounds of rejection that are neither necessitated by applicant's amendment of claims 3 and 4 nor based on information submitted in an information disclosure statement.

Accordingly, the finality of the rejection of claims 3-4 made within the Final Office Action is premature at least for this reason" (REMARKS, p. 9, last paragraph - p. 10, 2nd paragraph).

Examiner respectfully re-presents paragraph 13 of this Final Office Action:

"13. Applicant's arguments, filed on 02 March 2007, with regard to claims 3 and 4, have been fully considered but they are not persuasive. Applicant requests references regarding the previous ²rejection of these claims in the previous Office Action (mailed on 14

December 2006). Notice the newly cited references of Wiltsey and Presley. Accordingly, Applicant's arguments are not persuasive" (p. 9).

Examiner respectfully points out that paragraph 13 only states that there are *newly cited* references, not *new grounds of rejection*. That is, the presentation of these references were *in response to Applicant's request for such references* in Applicant's response filed on 02 March 2007. Furthermore, notice that the the grounds of rejection in this Final Office Action (mailed on 01 June 2007) remain the same as the grounds of rejection initially presented for these claims in the previous Non-final Office Action (mailed on 14 December 2006). That is, the same technical argument is presented in both actions. The references only provide documentary support for the initial technical argument. Therefore, there are no new grounds of rejection for claims 3 and 4. Accordingly, Applicant's argument against the finality of the most recent office action is not persuasive.